

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Glenn Mahony et al.

Serial No.: 10/606,677

Filed: June 26, 2003

For: HYBRID FIBER TO THE HOME/FIBER TO THE CURB TELECOMMUNICATIONS
APPARATUS AND METHODS

Group Art Unit: 2613

Examiner: Li, Shi K

Confirmation No.: 5379

Date: February 10, 2009

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed December 10, 2008. It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

I. The Examiner's Answer – Response to Arguments

Appellants will refrain herein from readdressing all of the deficiencies with the pending rejections and, therefore, in the interest of brevity, Appellants hereby incorporate herein the arguments set out in Appellants' Brief on Appeal as if set forth in their entirety.

The Examiner's Answer states that:

[i]n response to applicants' arguments that the Examiner has combined an excessive number of references, reliance on a large number of references in the rejection does not, without more, weigh against the obviousness of the claimed invention. *See In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

(Examiner's Answer, page 10.) Appellants respectfully agree that the large number references without more does not weigh against obviousness and note that the reliance on the large

number of references is evidence of the hindsight analysis used to reject Claims 1 and 24, which include significantly specific recitations relative to the cited references.

In response to Appellants' arguments that given the scope of the claim recitations, an obviousness rejection using the number of references that would have to be combined to read on the claims would necessarily be based on hindsight analysis and therefore be improper, the Examiner's Answer states that:

it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(Examiner's Answer, page 10.) Appellants respectfully submit that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). The rejection of Claims 1 and 24 appears to cobble together a rejection by selective extraction from six different references.

Presuming arguendo that the references show the element or concepts urged the Examiner's Answer presents no line of reasoning as to why the artisan in reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied upon to arrive at the claimed invention. In the instant application, the Examiner's Answer has done little more than cite references to show that one or more recitations or some combinations thereof, when each is viewed in a vacuum, is known. The claimed subject matter, however is clearly directed to a combination of elements. That is to say, the Appellants do not claim to have invented one or more new elements, but have presented claims to new combinations of elements. Appellants respectfully submit that an artisan would not have found it obvious to selectively pick and choose elements and/or concepts from the various references so as to arrive at the claimed subject matter without using the claims as a guide. For at least these reasons, Claim 1 is patentable over Feldman, Sala, Fitz, Singer, Dyke and Iglesia. Claim 24 includes similar recitations as Claim 1, and is patentable over Feldman, Sala, Fitz, Singer,

Dyke and Iglesia for at least the same reasons. Accordingly, Appellants respectfully request that the rejections of Claims 1 and 24 be reversed.

In response to Appellants' arguments that Feldman, Sala, Dyke, Fitz, Singer and Iglesia do not disclose or suggest "wherein a composite copper/fiber cable couples a host digital terminal (HDT) and the power source to the optical splitter and the ONU, respectively," as recited in Claim 17, the Examiner's Answer first states that:

Fitz teaches in FIG. 2 a composite copper/fiber cable for distributing power and optical signal from a central office (CO) or headend to ONU's. Sala et al teaches in FIG. 1 that the fiber form (sic) an OLT is further coupled to a splitter. Feldman et al. also teaches in FIG. 6 that a fiber from the headend is coupled to a splitter, which subtends the ONU.

(Examiner's Answer, page 11.) Appellants respectfully submit that even if the above allegations in the Examiner's Answer were individually correct, the combination thereof does not disclose or suggest that a HDT is coupled to an optical splitter and a power source is coupled to the ONU within the same composite copper/fiber cable. For at least these reasons, Claim 17 is patentable over Feldman, Sala, Fitz, Singer, Dyke and Iglesia. Accordingly, Appellants respectfully request that the rejection of Claim 17 be reversed.

The Examiner's Answer responds to Appellants' arguments that:

[t]he Final Action specifically states that nowhere does the instant specification teach that an ONU is coupled to both an OLT and a HDT. Final Action, page 2. Appellants submit that the Final Action appears to incorrectly interpret the claim language by apparently failing to consider the recited terms 'respectively' in the claims.

(Appellants' Brief, page 6, cited by Examiner's Answer, page 7.) In response thereto, the Examiner's Answer states that "[h]owever, instant specification does not teach both an OLT and a HDT are coupled to the same optical splitter." Examiner's Answer, page 7. Appellants respectfully submit that the Examiner's Answer appears to have changed the substantive basis of the rejection. As noted above, the rejection in the Final Action, upon which the portions of the Appellants' Brief on Appeal are based, in part, is directed to the relative configurations of an ONU, OLT and HDT and not, as redirected in the Examiner's Answer, to an OLT, HDT and optical splitter. Accordingly, the Examiner's Answer does not address the deficiencies of the Final Action that were raised in Appellants Brief on Appeal and, instead, provides what appears to be a new basis of rejection. Accordingly, the Examiner's Answer does not appear

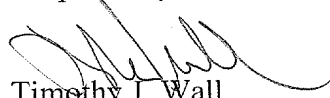
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to comply with the requirements of MPEP 1207.03 regarding a new ground of rejection in an Examiner's Answer. Accordingly, Appellants request that the rejections under 35 U.S.C. §112, first paragraph be withdrawn.

II. Conclusion

For the reasons set forth in above and in Appellants' Brief on Appeal, Appellants request reversal of the rejections of the claims, allowance of the claims and passing of the application to issue.

Respectfully submitted,



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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on February 10, 2009.



Michele P. McMahan